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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,847	01/31/2001	Harald Krondorfer	1466	6258

7590 07/09/2003

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[REDACTED] EXAMINER

TRAN, LOUIS B

ART UNIT	PAPER NUMBER
3721	17

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/774,847	KRONDORFER ET AL.
	Examiner Louis B Tran	Art Unit 3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 May 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

1. This action is in response to applicant's amendment, Paper No. 16, received on 5/23/2003.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jares (5,172,522) in view of Weber (DE 8701722 U1) in further view of Minamidate et al. (GB 2080920).

Jares discloses the invention substantially as claimed including a hand power tool comprising a housing 1, at least one handle having at least one gripping part 3 but does explicitly show said gripping part having a mounting side face towards the mounting part, an elastic vibration-damping element, mounted on said mounting part , said at least one gripping part being mounted on said housing through said elastic element and through said mounting element, and at least one additional safety element through which said gripping part is connected with said mounting part, said safety element being movable to avoid transmission of vibrations, through said safety element during predetermined operation.

However, Weber teaches the use of a gripping part 11 having a mounting side 7 facing towards the mounting part 6, at least one elastic, vibration damping element 5

mounted on said mounting part, said at least one gripping part 12 being mounted on said housing 1 through said elastic element and through said mounting element for the purpose of damping vibrations.

Therefore it would have been obvious to one having ordinary skill in the art to provide Jares with a handle with the specific features above in order to dampen vibrations.

Moreover, Minamidate et al. teaches the use of at least one additional safety element 3 fixed at a mounting side 5a,5b through which a mounting side of a gripping part is connected with a mounting part, said safety element being movable to avoid transmission of vibrations, through said safety element during predetermined operation(a portion of item 1) seen in Figure 1, a safety element 3 in the form of a flexurally non-rigid part (as in claim 2), as in column 2, line 101, formed as a rigid component which is connected through said elastic element with said gripping part and mounting part (as in claim 4), where elastic element surrounds safety element (as in claim 5), wherein safety element is arranged in said elastic element along a central axis ( as in claim 6), wherein safety element in a mounted condition is loaded by pulling and elastic element in a mounted condition is loaded by pressure (as in claim 7), as seen in Figure 1, and wherein safety element determines a maximum deviation of said elastic element from a base position a tilting direction (as in claim 9) for the purpose of providing vibration-damping while rigidly supporting a hand grip to facilitate positive control as described in column 1 line 25 of Minamidate et al.

Therefore, it would have been obvious for one having ordinary skill in the art to provide the modified device of Jares with the features above in order to provide vibration-damping while rigidly supporting a hand grip to facilitate positive control.

With respect to claim 3, the modified device of Jares discloses the claimed invention except for a safety element is formed as a metal wire. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a rope instead of a metal wire, since it is recognized that the equivalence of wires and ropes for their use in the art and the selection of any of these known equivalents to provide a connection between two objects would be within the level of ordinary skill in the art.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jares (5,172,522) in view of Weber (DE 8701722 U1) and Minamidate et al. (GB 2080920) as applied to claim 1 above, and further in view of Radle et al. (5,697,456).

The modified device of Jares discloses the invention substantially as claimed including a safety element but does not show a safety element formed as a band which surrounds said elastic element.

However, Radle et al. teaches the use of a safety element as a band 100 which surrounds an elastic element 98 for the purpose of acting as a covering element therefore protecting vibration dampening components from outside conditions as in column 6, line 20 seen in Figure 3.

Therefore, it would have been obvious for one having ordinary skill in the art to provide the modified device of Jares with a band acting as a cover in order to provide covering from outside elements.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jares (5,172,522) in view of Weber (DE 8701722 U1) in further view of Minamidate et al. (GB 2080920).

Jares discloses the invention substantially as claimed including a hand power tool comprising a housing 1, at least one handle having at least one gripping part 3 but does explicitly show said gripping part having a mounting side face towards the mounting part, an elastic vibration-damping element, mounted on said mounting part so as to keep the mounting part contactless from said gripping part, said at least one gripping part being mounted on said housing through said elastic element and through said mounting element, and at least one additional safety element fixed at said mounting side through which said mounting side of said gripping part is connected with said mounting part.

However, Weber teaches the use of a gripping part 11 having a mounting side 7 facing towards the mounting part 6, at least one elastic, vibration damping element 5 mounted on said mounting part so as to keep the mounting part contactless from said gripping part, said at least one gripping part 12 being mounted on said housing 1 through said elastic element and through said mounting element for the purpose of damping vibrations.

Therefore it would have been obvious to one having ordinary skill in the art to provide Jares with a handle with the specific features above in order to dampen vibrations.

Moreover, Minamide et al. teaches the use of at least one additional safety element 3 fixed at a mounting side 5a,5b through which a mounting side of a gripping part is connected with a mounting part (a portion of item 1) seen in Figure 1, for the purpose of providing vibration-damping while rigidly supporting a hand grip to facilitate positive control as described in column 1 line 25 of Minamide et al.

Therefore, it would have been obvious for one having ordinary skill in the art to provide the modified device of Jares with the features above in order to provide vibration-damping while rigidly supporting a hand grip to facilitate positive control.

### ***Conclusion***

6. Applicant's remarks have been fully considered but are deemed non-persuasive and moot in view of the new grounds of rejection.

Applicant contends that Minamide does not have a safety element but rather a tie rod to transmit vibrations. However, page 1, column 1, lines 25-29 indicate that the objective of the Minamide invention is two fold, "to provide a vibration-dampening handle which is capable of effectively damping hazardous vibrations whilst rigidly supporting a hand grip to facilitate positive control." Clearly, the tie rod of Minamide enables positive control and would satisfy the "safety element" claim limitation.

Applicant contends that Minamide teaches away from the present invention in that Minamide transmits vibration and applicant's invention is specifically constructed

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to avoid vibration. However, structurally, applicant has not defined the safety element with any such specific construction in the claims to distinguish over the prior art.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, applicant contends that the Minamidate tie rod is not connected to the receiving member via the elastic element. In response to applicant's argument that the tie rod is not connected via the elastic element, it is noted that the features upon which applicant relies (i.e., connected via the elastic element) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In claim 4, the limitation reads, "wherein said safety element is formed as a rigid component which is connected through said elastic element with said gripping part and said mounting part. Clearly, from Figure 1 of Minamidate, the tie rod or safety element is "through said elastic element".

In response to applicant's argument that Weber requires a metal core and would not be combinable with Minamidate, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary

reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). If examined carefully, the metal core of Weber resides only in the handle portion while vibrations are damped through the buffer 5. The requirement of a metal core in Weber is irrelevant to the concept of possessing a safety element or tie rod for increased positive control of a handle.

For the reasons above, the grounds of rejection are deemed proper.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

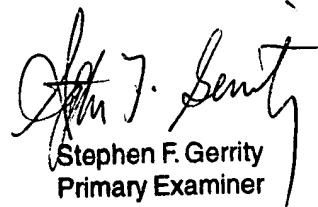
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Ibt  
July 1, 2003

  
Stephen F. Gerrity  
Primary Examiner